

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES M. LONG

Appeal No. 97-1691
Application No. 08/519,375¹

ON BRIEF

Before McCANDLISH, *Senior Administrative Judge*, MEISTER and
ABRAMS, *Administrative Patent Judges*.

MEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application for patent filed Aug 25, 1995. According to appellant, this application is a continuation of Application 08/227,432 filed April 14, 1994, now U.S. Patent No. 5,459,982 issued October 24, 1995.

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James M. Long (the appellant) appeals from the final rejection of claims 1-10, the only claims present in the application.

We AFFIRM.

The appellant's invention pertains to an apparatus for compressing and packaging microfibers. Independent claim 1 is further illustrative of the appealed subject matter and a copy thereof may be found on pages 2 and 3 of the brief.²

The references relied on by the examiner are:

Rieger	3,088,499	May 7, 1963
Strömberg	4,162,603	Jul. 31,
1979		
Long	5,459,982	Oct. 24,
1995		

Claims 1-10 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 5,459,982.³

² The appellant's brief is defective in that it does not contain an **appendix** containing a copy of the claims on appeal as expressly required by 37 CFR § 1.192(c)(9).

³ This rejection was set forth as a new ground of rejection in the answer.

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Claims 1-10 are rejected under 35 U.S.C. § 103 as being unpatentable over Rieger in view of Strömberg.

The arguments of the appellant and examiner in support of their respective positions may be found on pages 9-16 of the brief, pages 1-4 of the reply brief and pages 6-9 of the answer. As evidence of nonobviousness the appellant has relied on an affidavit by Bender.

OPINION

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and reply brief, and by the examiner in the answer. As a consequence of this review, we will sustain the rejection under the judicially created doctrine of obviousness-type double patenting. We will not, however, sustain the rejection under 35 U.S.C. § 103.

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Considering first the rejection under the judicially created doctrine of obviousness-type double patenting, it is the examiner's position that:

Although the conflicting claims are not identical, they are directed to the same inventive concept and are not patentably distinct from each other because the subject matter of the application claims is fully disclosed in the patent specification and covered by the patented claims. The patented claims are inclusive for they are drafted using the "comprising-type" format and cover the subject matter of the application claims(s). Since applicant has obtained the right to exclude others from making and using the subject matter set forth in the claims of this application by virtue of the patented claims, the issuance of this application into a patent without a terminal disclaimer as provided for under 37 CFR § 1.321(b) would amount to an unjustified extension of this right.

As stated IN [sic, in In] Re Schneller, 37 F.2d 350, 158 USPQ 210 (CCPA 1968), and quoted with approval IN [sic, in In] re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982), "the fundamental for the rule against double patenting is to prevent unjustified timewise extension of the right to exclude granted by a patent no matter how the extension is brought about." [Answer, pages 4 and 5.]

The appellant does not argue that 35 U.S.C. § 121 acts as a bar to a rejection based on obviousness-type double patenting in view of the restriction requirement in the

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application upon which the patent is based. Instead, it is the appellant's position that:

The claims of United States Patent '982 rely for patentability on different novel features of the novel compression packaging machine, i.e. see claim 14 [of] that patent, particularly lines 42-43 where patentability is based on the length of the compression chamber beyond the opening in which material is charged into the compression chamber and the structure and function of a pivot wall that forces the work product into the compression chamber. Claims 14, 15 and others of the '892 patent can be infringed without infringing the claims of the present application, e.g. a prior art retaining wall could be used since the retaining wall means is in the preamble of the improvement claims.

However, since at least a portion of the present invention is included in claim 1 of '892 in combination with other novel and unobvious features such as the structure and function of the pivot wall, a terminal disclaimer is included with this Reply Brief to remove this issue from the appeal.⁴ [Reply brief, page 2; footnote added.]

The appellant, however, has not presented any argument as to why the examiner erred in rejecting the appealed claims on obviousness-type double patenting with respect to claim 1 of the patent. Obviously, claim 1 of the patent could not be

⁴ However, the terminal disclaimer was deemed unacceptable by the examiner and not entered (see the response to the reply brief mailed February 19, 1997 (Paper No. 15)).

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infringed without infringing claim 1 of the instant application.

In view of the foregoing, we will sustain the rejection of claims 1-10 under the judicially created doctrine of obviousness-type double patenting.

Turning to the rejection of claims 1-10 under 35 U.S.C. § 103 as being unpatentable over Rieger in view of Strömberg, independent claim 1 expressly requires a retaining wall and

means for moving the retaining wall such that the surface in contact with the highly compressed mass moves away from said mass and then into ***an opening in a wall of said packaging chamber*** and in smooth alignment with said interior surface of said packaging chamber when in a second position
[Emphasis added.]

Recognizing that Rieger does not teach such a limitation, the examiner relies on the teachings of Strömberg for

the concept of a moveable retaining wall 29 that pivots into openings in the packaging chamber and back to its initial position as one of the walls of a compression chamber (figures 16a and 17a).
[Answer, page 7.]

However, as the appellant has correctly pointed out on page 10 of the brief, the covers or retaining walls 29 of Strömberg do not move into an ***opening in a packaging chamber*** as the

examiner asserts. Rather, these members move into an **open space** between the compression chamber 16 and roller conveyors 37 of a packing and binding device in order to "bridge the distance" (column 4, lines 65 and 66) between these two work stations. Since there is nothing in either Rieger or Strömberg which either teaches or fairly suggests a moveable retaining wall that pivots into an opening in a packaging chamber as expressly required by independent claim 1, the prior art relied on by the examiner fails to establish a **prima facie** case of obviousness with respect to the subject matter defined by claims 1-10.

Since the prior art relied on by the examiner fails to establish a **prima facie** case of obviousness, we need not consider the appellant's evidence of nonobviousness. **In re Fine**, 837 F.2d 1071, 1076, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

In view of the above, we will not sustain the rejection of claims 1-10 under 35 U.S.C. § 103 based on the combined teachings of Rieger and Strömberg.

In summary:

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The rejection of claims 1-10 under the judicially created doctrine of obviousness-type double patenting is affirmed.

The rejection of claims 1-10 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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NEAL E. ABRAMS)	
Administrative Patent Judge)	

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